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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/875,321

06/06/2001

Rory A.J. Curtis

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10/03/2003

INTELLECTUAL PROPERTY GROUP  
MILLENNIUM PHARMACEUTICALS INC.  
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CAMBRIDGE, MA 02139

EXAMINER

PAK, MICHAEL D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 10/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/875,321

Applicant(s)

CURTIS, RORY A.J.

Examiner

Michael Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7 and 12 drawn to an isolated nucleic acid molecule of 52906, vector, host cell, and method of producing polypeptide, classified in class 435, subclass 69.1.
  - II. Claims 1-7 and 12 drawn to an isolated nucleic acid molecule of 33408, vector, host cell, and method of producing polypeptide, classified in class 435, subclass 69.1.
  - III. Claims 1-7 and 12 drawn to an isolated nucleic acid molecule of 12189, vector, host cell, and method of producing polypeptide, classified in class 435, subclass 69.1.
  - IV. Claims 8-10, drawn to polypeptide of 52906, classified in class 530, subclass 350.
  - V. Claims 8-10, drawn to polypeptide of 33408, classified in class 530, subclass 350.
  - VI. Claims 8-10, drawn to polypeptide of 12189, classified in class 530, subclass 350.
  - VII. Claims 11, drawn to antibody against 52906, classified in class 530, subclass 387.9.
  - VIII. Claims 11, drawn to antibody against 33408, classified in class 530, subclass 387.9.

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- IX. Claims 11, drawn to antibody against 12189, classified in class 530, subclass 387.9.
- X. Claims 13-14, drawn to method for detecting the presence of a polypeptide of 52906 with antibody, classified in class 436, subclass 502.
- XI. Claims 13-14, drawn to method for detecting the presence of a polypeptide of 33408 with antibody, classified in class 436, subclass 502.
- XII. Claims 13-14, drawn to method for detecting the presence of a polypeptide of 12189 with antibody, classified in class 436, subclass 502.
- XIII. Claims 15, drawn to kit comprising the compound, classification could not be determined because the structure of the compound is not provided.
- XIV. Claims 16-17, drawn to a method for detecting the presence of a nucleic acid molecule of 52906, classified in class 435, subclass 6.
- XV. Claims 16-17, drawn to a method for detecting the presence of a nucleic acid molecule of 33408, classified in class 435, subclass 6.
- XVI. Claims 16-17, drawn to a method for detecting the presence of a nucleic acid molecule of 12189, classified in class 435, subclass 6.
- XVII. Claims 18, drawn to compound which hybridizes with 52906, classification could not be determined because the structure of the compound is not provided.
- XVIII. Claims 18, drawn to compound which hybridizes with 33408, classification could not be determined because the structure of the compound is not provided.

- XIX. Claims 18, drawn to compound which hybridizes with 12189, classification could not be determined because the structure of the compound is not provided.
- XX. Claims 19-20, drawn to method for identifying a compound which binds to a polypeptide of 52906, classified in class 435, subclass 7.2.
- XXI. Claims 19-20, drawn to method for identifying a compound which binds to a polypeptide of 33408, classified in class 435, subclass 7.2.
- XXII. Claims 19-20, drawn to method for identifying a compound which binds to a polypeptide of 12189, classified in class 435, subclass 7.2.
- XXIII. Claims 21-22, drawn to method for identifying a compound which modulates 52906 polypeptide, classified in class 435, subclass 378.
- XXIV. Claims 21-22, drawn to method for identifying a compound which modulates 33408 polypeptide, classified in class 435, subclass 378.
- XXV. Claims 21-22, drawn to method for identifying a compound which modulates 12189 polypeptide, classified in class 435, subclass 378.
- XXVI. Claims 23-24, drawn to method for treating or preventing an ion flux related disorder by administering peptide, classified in class 514, subclass 2.
- XXVII. Claims 23-24, drawn to method for treating or preventing an ion flux related disorder by administering phosphopeptide, classified in class 514, subclass 2.

XXVIII. Claims 23-24, drawn to method for treating or preventing an ion flux related disorder by administering small molecule, classification could not be determined because the structure of the compound is not provided.

XXIX. Claims 23-24, drawn to method for treating or preventing an ion flux related disorder by administering antibody, classified in class 424, subclass .

XXX. Claims 23 and 25, drawn to method for treating or preventing an ion flux related disorder by administering antisense, classified in class 514, subclass 44.

XXXI. Claims 23 and 25, drawn to method for treating or preventing an ion flux related disorder by administering ribozyme, classified in class 514, subclass 44.

XXXII. Claims 23 and 25, drawn to method for treating or preventing an ion flux related disorder by administering triple helix molecule, classification could not be determined because the structure of the compound is not provided.

XXXIII. Claims 26-27 and 29-30, drawn to method for identifying an agent which modulates expression of 52906 polypeptide with peptide and phosphopeptide, classified in class 435, subclass 378.

XXXIV. Claims 26-27 and 29-30, drawn to method for identifying an agent which modulates expression of 12189 polypeptide with peptide and phosphopeptide, classified in class 435, subclass 378.

XXXV. Claims 26-27 and 29-30, drawn to method for identifying an agent which modulates expression of 52906 polypeptide with antibody, classified in class 435, subclass 378.

XXXVI. Claims 26-30, drawn to method for identifying an agent which modulates expression of 12189 polypeptide with antibody, classified in class 435, subclass 378.

XXXVII. Claims 26-30, drawn to method for identifying an agent which modulates expression of 52906 polypeptide with small molecule, classified in class 435, subclass 378.

XXXVIII. Claims 26-30, drawn to method for identifying an agent which modulates expression of 12189 polypeptide with small molecule, classified in class 435, subclass 378.

XXXVII. Claims 26-30, drawn to method for identifying an agent which modulates expression of 52906 polypeptide with antisense, classified in class 435, subclass 378.

XXXVIII. Claims 31, drawn to antibody against 12189, classified in class 530, subclass 387.9.

The inventions are distinct, each from the other because of the following reasons.

The products of inventions Group I-IX, XVII-XIX, and XXXVIII are distinct each from the other, because they are drawn to products having materially different structures and functions.

The methods of inventions X-XVI and XX-XXXVII, are distinct, each from the other, because they are drawn to processes having materially different process steps, which are practiced for materially different purposes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Michael Pak

Primary Patent Examiner

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25 September 2003